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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,831	06/25/2003	Stephanie Howard	14382	9859
293	7590	08/16/2004	EXAMINER	
DOWELL & DOWELL PC SUITE 309 1215 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			KAVANAUGH, JOHN T	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,831	<b>Applicant(s)</b> HOWARD, STEPHANIE <span style="float: right;">CN</span>	
	<b>Examiner</b> Ted Kavanaugh	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 37-40 is/are rejected.
- 7) ☒ Claim(s) 30-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term "VELCRO" in claim 22 is indefinite because it would not be possible to reasonably determine what was encompassed by the trademark and what was not.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9,15-21,24,37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3408752 (Lollmann).

Lollmann teaches a skate boot as claimed including an opening facing rearwardly and upwardly of said skate boot for allowing insertion of the foot in said internal cavity (see col. 3, lines 18-25), a fastening device (4,5,6,7,8,9) having a released condition (see figure 2) and a fastened condition (see figure 1), a front opening (the opening between the side quarters 2', 2").

Regarding claims 37-40, the sports boot of Lollmann is inherently an ice skate and an inline skate inasmuch as it has all the structure as claimed. The terms "ice skate" and "inline skate" don't add any additional structure to the claim.

Art Unit: 3728

4. Claims 1-9,15-24,37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6295743 (Brooks).

Brooks teaches a boot having structure as claimed including an opening facing rearwardly and upwardly of said skate boot for allowing insertion of the foot in said internal cavity (opening between side flaps 28 and 30, see figure 2), a fastening device comprising a strap with VELCRO hook and loop sections (34a,34b,42,44) having a released condition (see figure 3) and a fastened condition (see figures 1 and 2), a front opening (the front opening between the side flaps 28,30).

Regarding claims 37-40, the boot of Brooks is inherently an ice skate and an inline skate inasmuch as it has all the structure as claimed. The terms "ice skate and "inline skate" don't add any additional structure to the claim.

5. Claims 1-8,15-23,37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5152084 (Bonnaventure).

Bonnaventure teaches a skate boot as claimed including an opening facing rearwardly and upwardly of said skate boot for allowing insertion of the foot in said internal cavity (the opening formed between the sides and covered by rear part 3), a fastening device (strap 30 and VELCRO) having a released condition (see figure 1) and a fastened condition (see figure 3).

Regarding claims 37-40, the ski boot of Lollmann is inherently an ice skate and an inline skate inasmuch as it has all the structure as claimed. The terms "ice skate and "inline skate" don't add any additional structure to the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-13 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lollmann '752 in view of US 5498033 (Hoshizaki et al).

Lollmann teaches a skate boot as claimed except for the front portion having stretchable portions having stretchable bands made of synthetic material. Hoshizaki teaches a skate boot comprising a stretchable portion (10). Regarding the synthetic material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bands out of synthetic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Regarding claim 13, Lollmann teaches an inner lining (26).

8. Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 13 and 28, respectively above, and further in view of US 487492 (Pugsley).

Pugsley teaches it has long been known in the art to provide a rigid insert enclosing the heel and medial and lateral ankle portions facing the medial and lateral malleoli respectively, see the entire disclosure. It would have been obvious to provide

Art Unit: 3728

the skate boot as taught above with a rigid insert, as taught by Pugsley, to provide further ankle support. Regarding the insert sandwiched between the outer shell and inner lining, the insert of Pugsley is taught to be located inside the footwear and it is well known and conventional in the art for the inner lining to be located next to the wearer's foot to provide comfort to the wearer. Therefore, it would be obvious to locate the insert sandwiched between the outer shell and the inner lining.

***Allowable Subject Matter***

9. Claims 30-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

11. Information about your application can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Telephone inquiries regarding other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners" M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.


In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM.

Application/Control Number: 10/602,831  
Art Unit: 3728

Page 7

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
August 13, 2004